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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,196	09/01/2004	Kuei-Jung Lee	WNCP0003USA4	5195
27765	7590	10/03/2006	EXAMINER	
NORTH AMERICA INTELLECTUAL PROPERTY CORPORATION P.O. BOX 506 MERRIFIELD, VA 22116			DANG, KHANH	
			ART UNIT	PAPER NUMBER
			2111	

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/711,196

Applicant(s)

LEE, KUEI-JUNG

Examiner

Khanh Dang

Art Unit

2111

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Notice to Applicants***

This Application, previously been assigned to and examined by Ex. Justin King, is now assigned to Ex. Khanh Dang. Any future contact should be directed to Ex. Khanh Dang whose contact information is provided at the end of this Office Action.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "CardBus port" and "CardBus" (claims 8, 9, 17, and 18).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

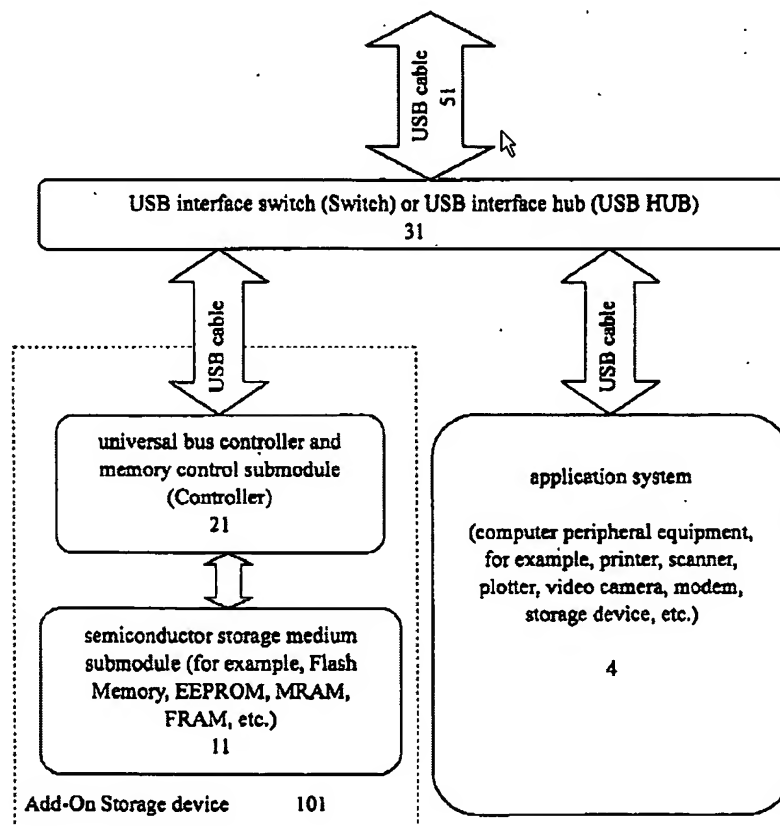
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 10-16, and 19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Deng et al. (Deng, 2004/0267987, cited by Applicants).

As broadly drafted and at best the Examiner can ascertain from the language of the claims, claims 1-7, 10-16, and 19-21 do not define any structure that differs from Deng.

With regard to claim 1, Deng discloses a peripheral device capable of being connected to an interface port on an electronic device host (as shown in Figs. 1 and 2; Fig. 2, for example, is shown below:



**FIG. 2**

, the peripheral device comprising: a housing (it is clear that the peripheral shown above must be at least enclosed in a housing); an application module positioned at least partially inside the housing (application system 4 is readable as "application module"); a

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storage module positioned inside the housing for storing a device driver of the application module and a firmware that can drive the storage module to simulate an autorun function of an optical disc drive (the storage device 101 is readable the "storage module. Deng also discloses that when the computer peripheral having additional storage function of the embodiment of the invention is connected to the host computer, it can be immediately identified by the host computer (using the self-provided drive program of the storage device in the host computer itself without any additional drive program). The drive program of the application system sub-device is found from the storage device and automatically installed by the host computer so that the automatic installation of the drive program of the application system sub-device is achieved; see at least [0010]; note that autorun function is used for automatically installed s driver from a disc); and a hub controller positioned inside the housing, the hub controller being electrically connected to the application module and the storage module (as shown above, it is clear that the hub 31 is connected to application module 4 and memory module 101; note that USB hub must include USB hub controller); wherein when the hub controller is electrically connected to the interface port, the electronic device host is capable of retrieving the device driver stored by the storage module and running the device driver to operate the application module (it is clear that the USB hub controller is connected to a USB port to connect to the USB host via a USB cable; and the host is capable of retrieving the device driver stored by the storage module and running the device driver to operate the application module; see at least [0100], [0002], [0004]-[0005], [0016]-[0017], [0036], [0041], 0081)).

With regard to claim 2, the peripheral device of Deng including a USB hub controller must be in full compliance with the USB specification. In paragraph [0056], Deng discloses that the peripheral connects with the USB interface of the host computer system, obtains the power supply from the USB interface 61, and turns on the Add-On Storage device 100; thereby initializing the USB interface and the storage device USB interface control sub-module 21; checking the Flash Memory sub-module 11, and reading the special information of Add-On Storage device 100. Deng further discloses a circuit schematic diagram of the internal USB interface switch 31 of the embodiment shown in FIG. 2. The pins of the USB connector are connected to the switch SW1 that can be shifted between two states, and in the first state, the connection can perform the application system 400 of the computer peripheral application function, and in the second state, pins of the USB connector are connected with AOSD through the resistances R1, R2 of 22 ohm, wherein there is a separate resistance of 1 mega ohm grounded between the R1, R2 and AOSD. In addition, Deng discloses a circuit schematic diagram of the internal storage device USB interface control sub-module 21. U5 is the USB controller, U4 is a three-terminal stabilized voltage supply of 3.3 v, and U4 provides the power of 3.3 v to U5. XT1 is a crystal oscillator of 6 MHz, which is connected with U5. See at least [0092]-[0093].

With regard to claim 3, see discussion above regarding claim 2.

With regard to claim 4, Deng discloses that the USB interface switch or USB interface hub 31 implements the function of the USB interface switch or USB interface hub, wherein the USB interface switch can select Add-On Storage device 100 to

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connect with the host computer, serving as a memory disk connected with the host computer, or select the application system 400 to connect with the host computer to operate directly, performing the function of the previous computer peripheral. Deng further discloses a circuit schematic diagram of the internal USB interface switch 31 of the embodiment shown in FIG. 2. The pins of the USB connector are connected to the switch SW1 that can be shifted between two states, and in the first state, the connection can perform the application system 400 of the computer peripheral application function, and in the second state, pins of the USB connector are connected with AOSD through the resistances R1, R2 of 22 ohm, wherein there is a separate resistance of 1 mega ohm grounded between the R1, R2 and AOSD. In addition, Deng discloses a circuit schematic diagram of the internal storage device USB interface control sub-module 21. U5 is the USB controller, U4 is a three-terminal stabilized voltage supply of 3.3 v, and U4 provides the power of 3.3 v to U5. XT1 is a crystal oscillator of 6 MHz, which is connected with U5. See at least [0092]-[0093]. Thus, it is clear that when the autorun detects that the driver is provided by the host, the power controller has to act accordingly to switch power to the application module so that it can get the driver from the host.

With regard to claim 5, see discussion above.

With regard to claim 6, it is clear from discussion above, and particularly [0092]-[0093] that if the driver is installed in the electronic device host, the firmware can send a control signal to the power controller for driving the power controller to deliver the predetermined voltage to the application device.

With regard to claim 7, it is clear from discussion above that the predetermined voltage is outputted from the electronic device host through the interface port.

With regard to claims 10-16 and 19-21, see discussion above, since the subject matter presented in claims 10-16 and 19-21 has already been addressed.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 8, 9, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deng.

As discussed above, Deng discloses the claimed invention including the use of "port" for providing connection between the host and a peripheral. Deng also discloses that alternatively IEEE-1394 protocol can be used instead of USB protocol.



Deng does not disclose the use of "CardBus port" and "CardBus."

However, the use of CardBus is old and well-known. CardBus is PC card (PCMCIA). PC Cards include USB PC Card and IEEE 1394 PC Card, for example, for providing USB and 1394 ports, respectively, to a host.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use CardBus to provide interface port for providing connection between the host and the peripheral, since the use of CardBus is old and well-known, and providing CardBus to Deng only involves ordinary skill in the art for the purpose of providing interface ports for connection between the host and the peripheral.

### ***Response to Arguments***

#### **The Provisional Double Patenting Rejection:**

The previously made Double Patenting Rejection is hereby withdrawn because "the applicant wishes to state for the record that co-pending Application No. 10/605,455 has been abandoned, which eliminates a possible provisional double patenting situation."

#### **Other Rejections:**

Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new grounds of rejection.

***Relevant Art***

US Patent Nos. 6,704,824 to Goodman, 6,574,588 to Shapiro et al., and 7,058,563 to Chrysanthakopoulos et al. are cited as relevant art.

Goodman discloses a USB adapter with automatic installation using autorun.inf, which is typically used for automatically installing a driver from an optical disc.

Shapiro discloses an composite device including a peripheral device and a memory for storing a driver for the peripheral device. The driver is automatically installed without intervention from a user when the integrated device is connected to a host.

Chrysanthakopoulos discloses a device driver autoload. Specifically, Chrysanthakopoulos discloses a composite device including a IEEE 1394 device and a memory for storing a driver of the IEEE 1394 device. Upon connecting to a host, the driver is automatically retrieved from the composite device and installed by the host.

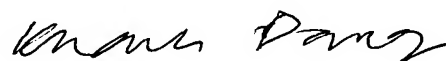
Non Patent Literature/Printed documents: USB Wireless LAN Media Access Controller from Atmel is also cited as relevant art.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh Dang whose telephone number is 571-272-3626. The examiner can normally be reached on Monday-Friday from 9:AM to 5:PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart, can be reached on 571-272-3632. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Khanh Dang  
Primary Examiner